

REMARKS

Claims 1, 3, 4, 6 and 8-11 are pending in the present application, and are rejected. Claims 2, 5 and 7 are withdrawn from consideration, and are herein canceled. No new matter has been presented.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1, 3, 6, 8 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,514,496 to Mishima et al. The Examiner admits that Mishima et al. does not specifically teach the carbon black specific surface area or the nitride average particle diameter. However, the Examiner asserts that it would have been obvious to provide carbon black and nitride having the claimed surface area and particle diameter as the electrode active material “in order to promote even mixing.”

Claims 4, 9 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mishima et al. in view of Numata et al. (US 2003/0082453 A1). With respect to Claim 4, the Examiner admits that Mishima et al. fails to teach a metal nitride including zirconium nitride. The Examiner concludes that one would have been motivated to modify the battery component of Mishima et al. with the zirconium nitride of Numata et al. because zirconium nitrides are chemically stable and heat generation due to oxidation and damage due to high voltage hardly occur, making zirconium nitride excellent in chemical stability at a high temperature and therefore preferable as an electrode material, as taught by Numata et al. in paragraph [0036].

In order to establish a *prima facie* case of obviousness, three criteria must be met. First, the prior art references when combined must teach or suggest all the claim limitations. Second, there must be some apparent reason or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. (Manual of Patent Examining Procedure (MPEP) §2142). The suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based merely on Applicant's disclosure.

Applicants respectfully disagree with the rejection, because even if the references were properly combined, not all of the claimed limitations are taught by the cited references, alone or in combination.

Applicants admit that Mishima et al. indeed appears to teach a nonaqueous secondary battery, which includes a positive electrode active material and a negative electrode active material. The electrode active material may include carbon black.

The Examiner asserts that Mishima et al. teaches that its electrolyte can include a nitride, and the Examiner appears to assert that this teaching is read upon by the claims.

However, with respect to the nitride in the positive electrode active material layer, the claims recite a conductive material, contained in said positive electrode active material layer, containing carbon black ... and a nitride having particles of at least 0.2 μm and not more than 5 μm in average particle diameter easily dispersed into said positive electrode active material layer

Because the nitride is dispersed in the positive electrode layer, the nitride of Mishima et al., which is part of the electrolyte therein, cannot be seen as equivalent or read upon by the nitride of the claimed invention. Therefore, Applicants respectfully submit that the Examiner has incorrectly characterized Mishima et al., and further submit that not all of the claimed limitations are met by the cited combination of references. Therefore, Applicants submit that the rejection of claims 1, 3, 6, 8 and 10 is improper and should be withdrawn.

With respect to claims 4, 9 and 11, Applicants note that they depend from claims 1, 6 and 10, respectively, and necessarily include at least the limitations therein. Because claims 1, 6 and 10 are seen as patentably distinguished from the cited references, Applicants submit that claims 4, 9 and 11 should be seen as necessarily distinguished as well.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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